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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/978,142	10/15/2001	Kazuya Kawasaki	JG-TT-5103 / 500568.20030	4088
26418	7590	05/26/2004	EXAMINER	
REED SMITH, LLP ATTN: PATENT RECORDS DEPARTMENT 599 LEXINGTON AVENUE, 29TH FLOOR NEW YORK, NY 10022-7650			SIEPKE, SAMUEL P	
			ART UNIT	PAPER NUMBER
			1743	

DATE MAILED: 05/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/978,142	KAWASAKI ET AL.	
	Examiner	Art Unit	
	Samuel P Siefke	1743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 3/9/04 have been fully considered but they are not persuasive. Applicant argues, "Terashima does not disclose, teach or suggest supplying a reagent solution on the spreading layer." The Office would like to point to column 8, lines 48-51, "In addition to the self-developing substrate, a light blocking fine particle or **reagents such as surfactants** may be incorporated into the **spreading layer** of the analytical element of the invention." Clearly this supports the limitation of adding a reagent solution on the spreading layer.

Applicant argues, "Terashima does not disclose coating the surface of the polyester fiber with an organic solvent prior to supplying a reagent solution nor teaches any advantage to doing this." The Office would like to point to column, 8, lines 51-55 which states, "These reagents may be ~~mixed~~ with the coating solution for the substrate to incorporate it in the spreading layer, **or the reagents** and the substrate may be separately incorporated in the spreading layer by other methods." Also column 8, lines 42-47, when the spreading layer is formed by coating, the spreading layer is composed of a brushed polymer layer or three-dimensional lattice-form structure using micro beads, the coating solutions for the substrate and the spreading layer **may** be mixed together and applied. It is the Office's position that equivalence is established when the prior art states that a coating layer **may be mixed**, and if not mixed and applied separately, the same outcome and results are observed.

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Applicant's arguments, see pages 7 and 8, filed 3/9/04, with respect to the rejection based on Kitajima under 35 U.S.C.102 (b) have been fully considered and are persuasive. The rejection of claims 3-8 have been withdrawn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims **3-8** are rejected under 35 U.S.C. 102(b) as being anticipated by Terashima et al. (USPN 4,900,665).

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5/25/04

Terashima discloses a method of producing a multi~~pl~~ayer analytical element that comprises a water-impermeable transparent support (col. 3, lines 54-65), at least one water-permeable layer (col. 4, lines 24-56), and a spreading layer which is composed of polyester and has a function of spreading liquid uniformly (col. 6, lines 7-68; col. 9, line 28 and line 51-52), laminated in this order, characterized in that surface of fiber constituting said spreading layer is coated with an organic solvent (col. 8, lines 23-49, specifically lines 35-38;), supplying a reagent solution on the spreading layer (col. 7, lines 50-68; col. 8, lines 48-51). The organic solvent is a lower alcohol containing 1 to 4 carbon atoms (ethanol, acetone, col. 8, lines 35-38). The organic solvent is supplied in an amount of 30 to 90% of the spreading layer by volume (col. 11, lines 10-30; col. 12,

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lines 43-64). The spreading layer after the organic solvent is dried until the amount of the organic solvent coating becomes 0.1 to 5% of the supplied amount. Terashima discloses allowing ample amount of time to dry, 60 ml m² amount of the solution was added to the spreading layer (col. 11, lines 15-18).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel P Siefke whose telephone number is 571-272-1262. The examiner can normally be reached on M-F 7:00am-5:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on 571-272-1700. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sam P. Siefke



May 19, 2004



JAN LUDLOW
PRIMARY EXAMINER